

lacked an enabling disclosure to the extent that the claims referred to "preventing" the effects of aging processes or harmful environmental effects on human skin or human hair. Applicants have deleted the reference to a preventive effect, and withdrawal of the Examiner's respective rejection is therefore respectfully solicited.

The Examiner rejected Claims 9 and 11 under 35 U.S.C. §102(b) as being anticipated by the teaching of *Eziri et al.* (US 4,728,650), pointing in particular to *Eziri et al.*'s description of a 5% ethanol solution of the chroman compound represented by applicants' formula (Ia) which is described in the context of Example 27 of *Eziri et al.*²⁾. Applicants' Claims 9 as herewith presented requires that the cosmetic preparation of the chroman of formula (Ia) comprise at least one further ingredient selected from a specific group of cosmetically suitable components which differ from the constituents of the 5% ethanol solution of the chroman compound described by *Eziri et al.* Anticipation under Section 102(a) requires that a prior art reference identically describe a claimed invention in as complete detail as is contained in the claims³⁾. Since applicants' cosmetic preparation differs from the ethanol solution described in *Eziri et al.*'s example, the preconditions for a finding of anticipation under Section 102 are not met. It is therefore respectfully requested that the respective rejection be withdrawn. Favorable action is solicited.

The Examiner rejected Claims 3 to 9 and 11 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Deckner et al.* when taken in view of the disclosure of *Wechter* (US 6,048,891 and US 6,555,575⁴⁾). The Examiner argued in this context that *Deckner et al.* teach a cosmetic composition comprising 6-hydroxy-2,5,7,8-tetramethylchroman-2-carboxylic acid in amounts of from 0.01 to 50% by weight as a free radical inhibitor, and that *Wechter* refers to carboxylic acid derivatives of tocopherols, including the chroman represented by applicants' formula (Ia), as antioxidants and free radical

2) Cf. col. 45, indicated line 58, to col. 46, indicated line 51, of US 4,728,650.

3) Cf. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (CAFC 1985); *In re Marshall* 577 F.2d 301, 198 USPQ 344 (CCPA 1978); *In re Kalm* 378 F.2d 959, 154 USPQ 10 (CCPA 1967); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (CAFC 1989); *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (CAFC 1984).

4) US 6,555,575 is related to US 6,048,891 through a number of continuation applications and the disclosure of US 6,555,575 is essentially identical to the disclosure of US 6,048,891. Applicants' following remarks referencing the disclosure of US 6,048,891 are, therefore, equally applicable where the disclosure of US 5,555,575 is concerned.

inhibitors. Based on the respective interpretation of the referenced art the Examiner concluded that it would have been obvious for a person of ordinary skill in the art to incorporate the tocopherol derivatives addressed by *Wechter* into the cosmetic composition taught by *Deckner et al.*

Applicants respectfully disagree with the Examiner's position regarding the information which is conveyed by the disclosure of *Wechter*. While *Wechter* generically states that the γ -tocopherol derivatives act as antioxidants and nitrogen oxide scavengers⁵⁾ it is also pointed out that the antioxidant effect of the compounds depends upon certain circumstances⁶⁾ and that individual members of the class of tocopherols may exhibit different biological properties from one another despite their structural similarities⁷⁾. Before this background, *Wechter* provides that chroman compounds which include the derivative represented by applicants' formula (Ia) exhibit natriuretic properties⁸⁾ which means that the compounds are capable to increase the rate of sodium excretion without contributing to significant potassium loss in mammals⁹⁾. The Examiner will also note that *Wechter* mentions, with regard to the representatives designated as "LLU- α " and "LLU- γ ", that the former compound exhibits natriuretic properties and also acts as a cardio-selective free-radical scavenger¹⁰⁾ whereas the latter compound is only effective as a natriuretic¹¹⁾.

The disclosure of *Wechter*, therefore, cannot reasonably be considered to teach or suggest to a person of ordinary skill in the art that applicants compound (Ia) could be useful as an antioxidant or a free-radical inhibitor. The disclosure of *Wechter* is even less suited to suggest or imply that the specific chroman which is represented by applicants formula (Ia) could be useful in the context of a cosmetic composition for the treatment of skin as defined in applicants' Claims 9 and 11. The disclosure of *Wechter* is equally unsuited to suggest or imply that the respective chromans could be employed to reduce the effects of aging processes or harmful environmental ef-

5) Cf. col. 1, indicated lines 6 to 15, of *US 6,048,891*.

6) Cf. col. 1, indicated line 30 et seq., of *US 6,048,891*.

7) Cf. col. 1, indicated line 44 et seq., of *US 6,048,891*.

8) Cf., for example, col. 6, indicated line 1 et seq., of *US 6,048,891*.

9) Cf. col. 4, indicated lines 28 to 31, of *US 6,048,891*.

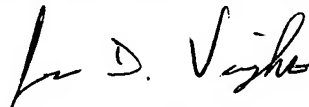
10) Cf. col. 11, indicated lines 12 to 23, of *US 6,048,891*.

11) Cf. col. 11, indicated lines 24 to 36, of *US 6,048,891*.

fects on human skin or human hair in accordance with the method defined in applicants' claims 3 to 8. It is also respectfully noted that the chroman compounds which are addressed in the disclosure of **Wechter et al.** are administered orally or parenterally¹²⁾, and not topically like the skin treatment compositions which are taught by **Deckner et al.** The disclosure of **Wechter** is therefore not deemed to contain anything which would reasonably have motivated a person of ordinary skill in the art to add any one of the natriuretic chroman compounds to the skin treatment composition of **Deckner et al.** To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify a reference or to combine references, and the teaching or suggestion to make the claimed combination must be found in the prior art and cannot be based on the applicant's disclosure¹³⁾. Since the motivation to make the necessary modification is lacking where the teaching of **Deckner et al.** and the disclosure of **Wechter** are concerned, the preconditions for a finding of obviousness under Section 103 are not met. It is therefore respectfully requested that the respective rejection be withdrawn. Favorable action is solicited.

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Respectfully submitted,
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Encl.: CLAIM AMENDMENTS (Appendix I)

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12) Cf. col. 16, indicated lines 27 to 30, of **US 6,048,891**.

13) In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438, 1442 (CAFC 1991)